

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/107,643 06/30/98 TRACY

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QM22/0307

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EXAMINER

WEBB, T

ART UNIT

PAPER NUMBER

3761

DATE MAILED:

03/07/01

209

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/107,643	TRACY, RHONDA
	Examiner	Art Unit
	Jamisue A. Webb	3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 February 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 7-40 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 7-40 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 24.

18) Interview Summary (PTO-413) Paper No(s). _____.

19) Notice of Informal Patent Application (PTO-152)

20) Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 2/2/01 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it lacks either a statement as specified in 37 CFR 1.97(e) or the proper filing fee as set forth in 37 CFR 1.17(p), and it lacks a list of the references as specified in 37 CFR 1.98(a)(1), such as the PTO-Form 1449. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 101

2. Claims 11 and 12 are rejected under 35 U.S.C. 101 because there exists a positive recitation of a human and/or human anatomy as part of the claimed invention. The phrase "contacts the skin of the wearer" includes the skin of the wearer as part of the claim. The examiner suggests the phrase "is capable of contacting the skin of the wearer" or "is provided to contact the skin of the wearer".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 7-8, 11-13, 15-16, 18, 21, 23-26, 28, 31, 33-36, and 38 rejected under 35

U.S.C. 102(b) as being anticipated by Foreman (US 4,816,025). 

5. With respect to Claim 7: Foreman discloses a standard hourglass shape diaper (Figure 1) having a plastic outer layer (column 8, lines 43-47) and a liquid absorbent layer (column 7, lines 41-56). Foreman discloses a soft padding member (see element 262, Figure 3; column 5, lines 56-58) located along at least one of the waist band portions, adjacent to the outer layer edge (the plastic layer edge), the soft padding member being distinct from the body portion layer, the soft padding member being located between the diaper wearer and the plastic layer edge when being worn by the wearer.

6. With respect to Claim 8: Foreman discloses a standard hourglass shape diaper (Figure 1) having a plastic outer layer (column 8, lines 43-47) and a liquid absorbent layer (column 7, lines 41-56). Foreman also discloses a strip of non-abrasive material (see element 262 shown in Figures 3, and column 5, lines 56-58) located along at least one of the waist band portions, adjacent to the outer layer edge (the plastic layer edge), the strip being distinct from the body portion layer, the strip providing a cushion between the diaper wearer and the outer layer (plastic layer) edge when being worn by the wearer.

7. With respect to Claims 11, 21 and 25: Foreman discloses a standard hourglass shape diaper (Figure 1) having a plastic bottom sheet 52, a topsheet (40), and a liquid absorbent layer (column 7, lines 41-56). Foreman also discloses the use of a horizontally oriented strip (262) being located in the waistband of the diaper (see Figure 1 and 3), the strip being distinct from the body portion layer, substantially rectangular in shape, and the strip being located between the wearer and the plastic edge being capable of contacting the skin of the wearer during use.

8. With respect to Claim 12, 13 and 23: Foreman discloses the strip being a soft padding member (column 5, lines 56-68), which provides cushion between the diaper wearer and the outer layer (plastic layer).

9. With respect to Claims 15-16, 25-26, and 28: Foreman discloses the strip being adjacent to the outer edge (the plastic edge), is parallel to the waist band (Figure 1) and is provided to be a barrier against leaks (column 10, lines 54-68).

10. With respect to Claim 24: Foreman disclose the strip (262) providing a thickness between the outer cover (plastic payer) and the wearer. As seen in Figure 1 and 3, the strip 262 is located between the wearer and the plastic layer, and has thickness associated with it, therefore the strip is considered to provide a discrete thickness between the plastic layer and the wearer.

11. With respect to Claim 31: Foreman discloses a standard hourglass shape diaper (Figure 1) having a plastic bottom sheet (52), a topsheet (40), and a liquid absorbent layer (column 7, lines 41-56). Foreman also discloses the use of vertically oriented strips (62) being located at the leg hole of the diaper (see Figure 1 and 2), the strip being distinct from the body portion layer, and the strip being located between the wearer and the plastic edge.

12. With respect to Claim 32 and 33: Foreman discloses the strip being a soft padding member, which provides cushion between the diaper wearer and the outer layer (plastic layer). The barrier flaps located at the leg openings, and the barrier flap located at the waist opening, are configured the same and made from the same material. Foreman discloses the strip at the waist opening to be a padding member (column 5, lines 55-60). Therefore the examiner considers the barrier cuff at the leg opening to also be a padding member which provides cushion.

13. With respect to Claim 35, 36 and 38: Foreman discloses the strip being adjacent to the outer edge (the plastic edge), is parallel to the leg openings (Figure 1) and is provided to be a barrier against leaks (column 10, lines 54-68).

14. It is also noted that Webster's dictionary's definition of soft is something that is easily, cut, worked, or molded, or something that yields readily to pressure or weight. The barrier cuffs disclosed by Foreman are made readily conform to the general shape and contours of the body (column 10, lines 57-62), and therefore yields readily to pressure and therefore is soft.

15. To the extent that the applicant may argue that the cuff of Foreman is not a "soft padding member" the following rejection is additionally being made.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 7, 12, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foreman (US 4,816,025) in view of Lindquist (US 3,572,342). ✓

18. Foreman, as described above, fails to teach the use of a "padding member".

19. Lindquist teaches in the same field of endeavor to provide padding elements (37 and 38 for the waist, 35 and 36 for the legs) made of foam applied along the portion of the diaper at which seepage of fluids is not desired along the upper surface.

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the upper surface of barrier cuffs 62 and 262 of Foreman with padding elements made of foam, as disclosed by Lindquist) in order to retard fluid. (See column 1, lines 15-20 of Lindquist)

21. Claims 7-40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McConnell et al. (US 3,461,872). ✓

22. With respect to Claims 7, 8, 11-13, 15-17, 18-21, 23, 25-33, and 35-40 : McConnell discloses a diaper retaining garment (Figure 1) including an absorbent pad (26 and 27)(Figures 5 and 6). The body includes two enlarged end portions, a narrowed intermediate portion, a waist band portion a waist band portion at leach end, and two leg openings. The garment further includes a liquid absorbent layer (26), a topsheet (27), a plastic backsheets layer (10) having an edge at the edge of the diaper (the body portion, 10, of a flexible polymeric cellular material, an open celled foam such as polyurethane is a plastic layer, see column 4, lines 15-20) and a soft padding member (which is also a non-abrasive strip, see element 22 in figures) located along at least one of the waist band portions and the leg openings adjacent and parallel to the plastic edge,

so that the soft (non-abrasive) substance is located between the diaper wearer and the plastic layer edge, such that the diaper presents a soft (non-abrasive) surface at the waistband portion and the leg openings despite the plastic edge. McConnell discloses that the padding member is a distinct piece of material that is made from woven fabric or scrim (column 3, lines 30-39). Scrim is a piece of cotton material, and the examiner considers the strips made of cotton to be a soft padding member that can be used as a cushion. Cotton is an absorbent material, and therefore fully capable of being used as a barrier against leaks. The strips are horizontally oriented and generally rectangular in shape (see Figures 1 and 2).

23. McConnell discloses:

The elasticized edges 11, 12, 18 and 19, are preferably covered by fabric outer strip 22 to prevent contact of the wearer with the elastic material forming strip 1. This strip 22 is sewn on along with the elasticized strip 21 and forms an envelope around it. The details of this construction feature can clearly be seen from Figure 2. The material forming the outer strip 22 may comprise any type of flexible material, but is preferably a woven fabric or scrim.” (column 3, lines 30-39)

24. The outer strip 22 wraps around the elastic (21) and the body (10), this it inherently presents a soft surface or a non-abrasive surface a the waistband portion. According to the Webster’s Dictionary “scrim” is usually a cotton fabric. Also, McConnell states the elasticized edges are covered by a fabric outer strip 22 to prevent contact of the wearer with the elastic material, this it is inherently a soft material. If it is not inherent, that the material is soft and non-abrasive, then it would have been obvious to one of ordinary skill in the art at the time the invention was made because it is well recognized that babies skin is soft and easily irritated.

Why else would McConnell cover the elastic strip with a fabric to prevent the contact of the wearer with the elastic. One of ordinary skill in the art would not cover an elastic with a hard or abrasive material as it defeats the purpose of covering it.

25. With respect to Claims 9, 10, 14, 22 and 34: McConnell discloses the strip of soft padding member extends from the inside to the outside of the diaper (see Figure 2), thereby capable of softening the edge of effect of the plastic edge on the wearer.

26. With respect to Claim 24: McConnell disclose the strip (22) providing a thickness between the outer cover (plastic payer) and the wearer. As seen in Figure 1, 2 and 6 the strip 22 is located between the wearer and the plastic layer, and has thickness associated with it, therefore the strip is considered to provide a discrete thickness between the plastic layer and the wearer.

27. Additionally, it is noted that applicant's declaration states that the cotton around the waistline and leg lines of the diaper is a very fine, small layer of cotton, which would be very similar, but not exactly the same as that of a gauze pad or the inside of a gauze pad. McConnell discloses the use of a "woven fabric or scrim" which is easily the same thing.

Terminal Disclaimer

28. The terminal disclaimer filed on 2/2/01 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patents 5,797,824 and 5,064,421 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Amendment

29. With regards to the Information Disclosure Statement, of the court ruling of November 2000: the examiner has not considered this reference, due to reasons stated above, in this Information Disclosure Statement section of this office action.

30. The Amendment submitted February 2, 2001 has been entered, but arguments are not persuasive. See rejection above.

31. Regarding the effective filing date of the claims: a patent application is entitled to the benefit of the filing date of an earlier filed application, if the disclosure of the earlier application provides support for the claims of the later application, a design application provides support for structural claims and does not provide support for material claims, therefore does not provide support for the strip being a soft padding material, the strip being non-abrasive, or the diaper's outer cover being plastic. Therefore the newly added claims 11-40, as well as the old claims 7-10, do not receive the benefit of the 1987 filing date, but instead has an effective filing date of April 30, 1990.

32. With regards to applicant's argument that Foreman does not disclose a soft padding member: Foreman discloses the use of a barrier cuff (which the examiner considers to be the soft padding member) having a soft non-jagged edge. The examiner considers the fact that if the edge is soft and non-jagged, then the cuff is soft, and the cuff is placed between the wearer and the waist of the diaper, so the examiner considers this to be a form of padding, and it is a member of the diaper. The applicant claims that the member is made from a material that is formed from a soft substance, Foreman discloses that the edge of the strip is soft, therefore the examiner considers the strip to be made from a soft substance. (See rejection above).

33. With regards to applicant's argument that that 103 rejection of Foreman in view of Lindquist is not obvious: Lindquist clearly describes the foam strips running along both legs and both waist openings, see rejection above. In fact, the only figure where reference numerals 37 and 38 are located, is the figure in where it clearly shows that there are two sets of foam strips, one set in the waist opening, and one set in the leg openings. The reference Lindquist provides suggestion and provides motivation to combine the two references by saying "placing the hydrophobic strips along each side of the diaper on the surface which is adjacent the child when the diaper is in place". The barrier cuffs of Foreman are adjacent the skin of the wearer, therefore it would have been obvious to combine Foreman with Lindquist.

34. With respect to applicant's argument that McConnell does not disclose a disposable diaper, but instead a diaper retaining garment: McConnell discloses the plastic retaining garment with an absorbent pad located inside the garment. In Figure 6, there exist the plastic retaining garment, and the absorbent pad, with the topsheet placed in side. Although the outer plastic cover is reusable, it is fully capable of being disposed, and the inside pad is also disposable after one use. Therefore the examiner considers McConnell to teach the use of a disposable diaper, with a plastic backsheet, a topsheet and an absorbent core located there between (see figure 6).

35. With respect to applicant's argument that the PTO Board of Patent Appeals and Interference has already stated McConnell was deficient: The PTO BPAI decision was not for this case, and therefore the BPAI has not considered the McConnell reference as it is now being applied. McConnell does disclose a plastic layer extending to the edge (see Figure 2, column 4, lines 15-17). Webster's II New Riverside Dictionary defines plastic as "adjective-capable of being formed or shaped" and "noun-any various complex organic compounds produced by

polymerization, capable of being molded, extruded, cast into various shapes and films, or drawn into filaments used as textile fibers", McConnell discloses the outer cover being a flexible polymeric cellular material being made from a polyurethane foam (which is an organic compound that is polymerized). As shown in Figure 2, there is the elastic strip 21, covered by the padding 22, and the plastic outer cover is located at the edge. Figure 2 is a cross section of the middle of the diaper extending from one leg opening to the other, however Figure 1 shows no difference in structure at the leg openings and the waist opening, therefore the examiner considers there to be a plastic edge that is located at the edge of the outer cover in the waist region.

36. With regards to the Terminal Disclaimer filed three times: the previous terminal disclaimers were not in proper form (see MPEP 1490), therefore a new terminal disclaimer was needed to overcome the double patenting rejection.

37. With regards to applicant's argument that Foreman is invalid: Due to the fact that none of the claims receive the 1987 filing date, due to the outer cover being plastic, Foreman is a 102(b) reference, and therefore the applicant cannot swear behind the Foreman reference. Examiner has already stated earlier, in the rejection statement, as well as in the response to amendment section, why the examiner considers the Foreman reference to be valid, therefore the rejection stands as stated above.

38. With regards to applicant's argument that the added claims receive the benefit of the earlier filing date: the design patent can only be relied on for structural purposes, therefore there is no way to tell if the outer cover is plastic, and therefore the new claims do not receive the benefit of the 1987 filing date. Therefore they are rejected using Foreman, as stated above in the

rejection section. Once again the Foreman is a 102(b) reference, therefore the applicant cannot swear behind the reference.

39. With regards to applicant's arguments that the examiner should withdraw the McConnell reference based on the PTO BPAI decision in a previous case in 1997: The PTO BPAI, has not considered the McConnell reference as it is not being applied, and therefore the rejections based on McConnell stands, as stated above. The PTO BPAI decision was for a different case, and the claims were generally the same, but were now exactly the same, therefore the Board may discuss the deficiencies of McConnell, but the Board discusses the deficiencies based solely on the how the McConnell reference was applied to those specific claims that were filed in the 1997 case. The claims are different, as well as the rejections are different, and therefore the Board has not considered the McConnell reference as it is now being applied. The examiner considers the McConnell reference to still be applicable, and the rejection stands as stated above.

Conclusion

40. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (8:30 - 5:00).

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

jaw *sw*
March 5, 2001

DR *DRW*
DENNIS RUHL
PRIMARY EXAMINER